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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,835	02/18/2004	Richard A. Elco	FCI-2780/C2285B	3750

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EXAMINER	
LEE, BENNY T	

ART UNIT	PAPER NUMBER
2817	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Washington, D.C. 20231

FILING DATE

10/780835

EXAMINER

ART UNIT

PAPER NUMBER

☐ This application has been examined ☒ Responsive to communication filed on 19 Nov 2004. ☒ This action is made final.

A shortened statutory period for response to this action is set to expire Three (3) month(s), ~~days~~ from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1 - 14 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1 - 4, 6 - 11; 12, 13; 14 are rejected.

5. ☒ Claims 5 ~~are~~ is objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☒ The proposed additional or substitute sheet(s) of drawings, filed on 19 Nov 2004, has (have) been ☒ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

The disclosure is objected to because of the following informalities: Page 5, paragraph [0031], note that it is unclear in view of the detail description of "figure 15A" whether such a backplane system should also be designated as --prior art--? Page 5, in replacement paragraph (0033), it remains unclear whether figure 16, as amended, is properly intended to be associated with prior art "figure 13A." or "figure 15A", as described in the last few sentences of replacement paragraph [0057]. Clarification is needed. Page 7, in replacement paragraph [0040], seventh line therein, note that "7-axis" should correctly be --y-axis--. Page 8, paragraph [0047], note that "a width, a" should be rephrased as --a width designated by a--. Page 11, in replacement paragraph [0057], note that the description of "figure 16" does not appear to be consistent with the brief description of "figure 16" as recited in paragraph [0033]. Clarification is needed. Note that further elaboration as to the nature of the curve as depicted in figure 14 need to be provided, since such description is lacking from the specification. Appropriate correction is required.

The drawings are objected to because of the following: In fig. 8, note that for each "b/a" ratio, such ratio should be spaced farther to the right of the corresponding recited waveguide mode; In figure 15, should this drawing figure also be labeled --PRIOR ART-- since it does not appear to include the slots for mode suppression (e.g. see Fig. 15B)? Clarification is needed. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be

renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-11; 12; 13; 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7 of U.S. Patent No. 6590477. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims recite an inventive embodiment, which is not patentably distinct from the claimed embodiment of the co-pending patent. Although the patent claims do not explicitly recite first and second substrates, it should be noted that in an obviousness double patenting rejection, the teachings in those portions of the specification which support the patent claims can also be relied on in an obviousness double patenting rejection (see

MPEP 804(II)(B)(1). For the particular patent the relied upon patent claims correspond to and hence is only supported by the embodiment of Fig. 7B. As is evident from the fig. 7B embodiment in addition to the claim waveguide configuration and function, such prefabricated (e.g. by bending, etc) waveguides are sandwiched and affixed (e.g. by gluing, etc) between upper and lower dielectric substrates (118A, 118B). Accordingly, the relied upon patent claims and the patent's specification support thereof suggests that the scope of coverage of the relied upon patent claims encompasses the dielectric substrates in Fig. 7B embodiment, despite lack of any explicit recitation of the dielectric substrates. Thus, for this reason, the patent and application claims are not patentably distinct from each other.

Applicant's arguments filed 19 November 2004 have been fully considered but they are not persuasive.

With respect to the obviousness double patenting rejection, applicant has argued that the backplane claims in the present application were subject to a restriction requirement in the grandparent application and accordingly those claims can not be subjected to an obviousness double patenting rejection since 35 USC 121© prohibits the application of obviousness double patenting against the claims of the present application by the claims of the grandparent application, by virtue of the restriction requirement made in the grandparent application.

While the above arguments are generally true, there are certain exceptions to the general prohibition under 35 USC 121©. One of the exceptions is if the claims presented in the present application are not commensurate with the claims, which were subject to restriction in the grandparent application. See MPEP 804.01(B). Note that in the restriction requirement made in the grandparent application, non-elected claims 10-15 were directed to a backplane system

having limitation which were most readable on Figure 4, while the present claims are directed to a backplane system include two substrates, which is readable on Figure 7B. Therefore, since the embodiment readable by the presently presented claims is not commensurate to the embodiment readable on the claims restricted out in the grandparent application, the 35 USC 121 prohibition on obviousness double patenting does not apply as set forth by the exception in MPEP 804.01(B).

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Benny T. Lee at telephone number (571)-272-1764.

B. Lee

Benny Lee

BENNY T. LEE
PRIMARY EXAMINER
ART UNIT 2817